



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/552,243 | 06/14/2006 | Jochen Schreiber | 23414 | 8850 |
| 535 7590 11/13/2008 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900 | | | | |
| EXAMINER | | | | |
| VANATTA, AMY B | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3765 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 11/13/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,243

Applicant(s)

SCHREIBER ET AL.

Examiner

Amy B. Vanatta

Art Unit

3765

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4-6, 8, 9, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4-6, 8, 9, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 081208
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2, 4-6, 8, 9, 23, and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method comprising hydrodynamic needling of a *nonwoven* fabric formed at least partially of metal fibers or metal filaments, does not reasonably provide enablement for a method comprising providing a *knitted or woven fabric at least partially formed of spun yarns* of metal fibers or metal filaments and hydrodynamically needling the fabric. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the method of the invention commensurate in scope with these claims.

The specification discloses only the manner of performing the hydrodynamic needling of a *nonwoven* fabric. The specification merely discloses in the first paragraph that woven fabric or knitted fabric consisting of metal fibers or filaments may be stitch-bonded or finished, however the details of such a stitch-bonding or hydrodynamic needling of a woven or knitted fabric comprising metal fibers or filaments is not further taught. The conditions under which such hydrodynamic needling of the knitted or woven fabric is performed are not adequately disclosed.

The specification focuses on teaching how to perform the method of the invention on a nonwoven. The specification elaborates the advantages of hydrodynamic needling

of a nonwoven which comprises metal fibers or filaments. The specification discloses that the method of the invention is advantageous since hydrodynamic needling of a nonwoven avoids "time-consuming thread formation" (see Object of the Invention), and thus appears to teach away from the hydrodynamic needling of a knitted or woven fabric, which would require such a thread formation out of the metal fibers or filaments.

The specification also does not teach how formation of a woven fabric which "at least partially avoids yarn formation from unspun metal fibers" is carried out, such as recited in claim 2. Also, the specification does not adequately teach how to combine metal fiber woven fabrics, knit fabrics, and/or stitch-bonded materials as in claim 8.

Thus, the specification fails to adequately teach how to perform the claimed method on a knitted or woven fabric of spun yarns of metal fibers or metal filaments.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is indefinite in that it is unclear in what manner the recitations of claim 8 further limit the method of claim 23 (from which claim 8 depends). It is unclear how the recitations of claim 8 are related to the method steps of claim 23.

Claim 8 is also indefinite in that it is unclear exactly what method steps are being claimed. Additionally, the recitation of "knit fabrics, knitted fabrics" is confusing in that it is unclear what the difference is between these two recited types of fabric.

Claim 9 recites "the water jet stitch" without proper antecedent basis.

Response to Arguments

5. Applicant's arguments with respect to Rogers and Kyutoku et al have been considered but are moot in view of the new ground(s) of rejection under 35 U.S.C. 112, first paragraph. It is noted that the claim amendments filed 8/12/08 define over Rogers and Kyutoku et al.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy B. Vanatta whose telephone number is 571-272-4995. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amy B Vanatta/
Primary Examiner
Art Unit 3765